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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,047	09/23/1999	PRADEEP IYER	AVERP2511USA	7985

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EXAMINER

LEE, RIP A

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/404,047

Applicant(s)

IYER ET AL.

Examiner

Rip A. Lee

Art Unit

1713

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 and 58-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action follows a petition for revival of an application for patent abandoned unintentionally under 37 CFR 1.137 (b), filed on October 29, 2002. The petition was granted on November 13, 2002.

Applicants have amended claims 1, 4, 8, 9, 11, 13, 14, 16, 18, 22, 25, 30, 33, 36-39, 41, and 42 to correct matters of form. Claims 47-57 were canceled. New claims 58-60 were added.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 58-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no indication in the present application that the specific range of 12-30 wt % of component (b) is to be used. As such, the claims contain new subject matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-16, 22, and 25-42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,812,541 to Mallya *et al.*

Mallya *et al.* teaches a copolymer comprised of (a) 55-85 % C<sub>4-12</sub> alkyl (meth)acrylate ester, (b) 1-10 % *N*-vinyl lactam, (c) 0-15 % unsaturated carboxylic acid, and (d) a crosslinkable, glycidyl monomer in 0.01-2 % by weight of the entire mixture. The composition also contains up to 35 % of C<sub>1-4</sub> alkyl (meth)acrylate ester (claims 1 and 18). The amounts of these components fall within or lie about the ranges described in the present invention. The identities of the types of compounds that can be used within each class of components are disclosed (col. 3, lines 50 – col. 4, line 6), and these are consistent with those listed in the claims of the present invention. The adhesive copolymer has a glass transition temperature,  $T_g$ , less than about -15 °C (claim 1). The composition is further comprised of specifically defined copolymerizable monomers such as polystyryl ethyl methacrylate and acetoacetoxyl ethyl methacrylate, among others (claim 2).

Mallya *et al.* does not teach a blend of two pressure sensitive adhesive compositions as presently claimed. However, it is noted that the combination of the two blends recited in present claims 22 and 25 results in an overall pressure sensitive adhesive composition that is essentially the same as that claimed in the parent claim. The overall, blended, composition would contain (a) a major amount of (meth)acrylate ester, (b) about 0.5-30 wt % of nitrogen containing monomer, (c) 0.5-15 wt % of unsaturated carboxylic acid, and (d) a crosslinkable monomer. As such, this composition would still be anticipated by the prior art.

7. Claims 1-14, 17, 19-39, 43, 45, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,639,811 to Plamthottam *et al.*

Plamthottam *et al.* claim a copolymer comprised of (a) 55-85 % C<sub>4-12</sub> alkyl (meth)acrylate ester, (b) 0-30 % *N*-vinyl lactam, (c) 0-15 % unsaturated carboxylic acid, (d) 0.01-2 % of a crosslinkable, glycidyl monomer, and (e) 0-35 % C<sub>1-4</sub> alkyl (meth)acrylate ester (claim 1). The identities of the types of compounds that can be used within each class of component are disclosed (col. 3, lines 37-64), and these are consistent with those listed in the claims of the present invention. The copolymer has a glass transition temperature,  $T_g$ , less than about -15 °C (claim 1). A tackifier is incorporated into the mixture (claim 1). The use of plasticizers and other addenda is contemplated (col. 5, lines 23-25), and use of aluminum acetylacetonate as crosslinking agent is also taught (col. 8, line 30).

Plamthottam *et al.* does not teach a blend of two pressure sensitive adhesive compositions as presently claimed. However, it is noted that the combination of the two blends recited in present claims 22 and 25 results in an overall pressure sensitive adhesive composition that is essentially the same as that claimed in the parent claim. The overall, blended, composition would contain (a) a major amount of (meth)acrylate ester, (b) about 0.5-30 wt % of nitrogen containing monomer, (c) 0.5-15 wt % of unsaturated carboxylic acid, and (d) a crosslinkable monomer. As such, this composition would still be anticipated by the prior art.

8. Claims 18 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plamthottam *et al.* in view of U.S. Patent No. 5,215,818 to Coopridner *et al.*

Although the use of plasticizers and other addenda is contemplated in Plamthottam *et al.*, the inventors do not elucidate the nature of said plasticizer. Coopridner *et al.* teaches the use of standard materials, for example, dioctyl phthalate, 2-ethyl hexyl phosphate and cresyl phosphate (col. 7, lines 59-61), as useful plasticizers for acrylate based pressure sensitive adhesives (col. 3-4). Therefore, one having ordinary skill in the art would have found it obvious to use the plasticizers disclosed in Coopridner *et al.* in pressure sensitive adhesive compositions, as contemplated by Plamthottam *et al.*

#### ***Response to Arguments***

9. The Applicants traverse the rejection of claims 1, 3-8, 10-17, and 19-21 under U.S.C. 102(b) as being anticipated by Mallya *et al.* and Plamthottam *et al.* The Applicant's arguments have been considered fully, but they are not persuasive.

The Applicants maintain that neither reference can anticipate the subject matter of the present claims because the working examples shown therein illustrate pressure sensitive adhesive compositions in which 4 % by weight, at most, of nitrogen containing monomer is used. As such, the Applicants indicate that these examples do not reflect the compositions of the present claims which require 8-30 wt % of nitrogen containing monomer.

The examples merely illustrate the invention in a non-limiting manner, as indicated by Mallya *et al.* (col. 5, line 1) and Plamthottam *et al.* (col. 7, line 38). Therefore, unrecited examples that adhere to the claims also fall within the realm of the invention of the prior art. The present invention calls for the use of 8-30 wt % of nitrogen containing monomer such as *N*-vinyl pyrrolidone. The composition disclosed in claim 1 of Mallya *et al.* contains 1-10 % of a *N*-vinyl lactam monomer, and the adhesive described in claim 1 of Plamthottam *et al.* contains 0-30 % of *N*-vinyl lactam monomer. As such, the required amount of said monomer, set forth in the current application, is met in both references.

In view of the discussion above, the rejection of record has not been withdrawn.

10. The following claim rejections, traversed by Applicants, have been withdrawn:

- (a) Rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Mallya *et al.*
- (b) Rejection of claims 22-35, 37-43, 45, and 46 under 35 U.S.C. 103(a) as being unpatentable over Plamthottam *et al.* in view of Mallya *et al.*



***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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March 4, 2003

  
DAVID W. WU  
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